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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,151	01/08/2001	James S. Boyce	10003916-1	6995

7590            02/17/2006

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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MENBERU, BENIYAM

ART UNIT	PAPER NUMBER
	2626

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/757,151	BOYCE, JAMES S.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Beniyam Menberu	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 January 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4-7,10-13 and 16-18 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-7,10-13 and 16-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6934044 to Khandelwal in view of U.S. Patent No. 6782402 to Hidaka et al.

Regarding claims 1, 7, and 13, Khandelwal disclose a method, system, and program for delivering a file from a client to a server for printing, wherein the name of the file includes an extension, the method comprising: wherein the name of the file includes an extension (column 4, lines 18-22); comparing the extension of the file to a list of print ready extensions (column 4, lines 21-23); responsive to a match between the extension of the file and a print ready extension, realizing the file type is print ready (column 4, lines 2-5, lines 20-25, lines 37-40; column 1, lines 5-16);

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responsive to a print ready file type, initiating a write of the file to the server (column 4, lines 20-26).

However Khandelwal does not disclose receiving a path and a name of the file to be delivered from the client to the server for printing.

Hidaka et al disclose receiving a path and a name of the file to be delivered from the client to the server for printing (column 32, lines 51- 59; column 10, lines 6-10).

Khandelwal and Hidaka et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine file name/path specification of Hidaka et al with file extension comparison of Khandelwal to implement printing of file by a server using path name and file name with extension.

The motivation to combine the reference is clear because the path and file name is needed to identify a specific file for printing.

4. Claims 4, 5, 10, 11, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6934044 to Khandelwal in view of U.S. Patent No. 6782402 to Hidaka et al further in view of U.S. Patent No. 5963641 to Crandall et al.

Regarding claims 4, 10, and 16, Khandelwal in view of Hidaka et al teach all the limitations of claims 1, 7, and 13 respectively. However Khandelwal in view of Hidaka et al does not disclose method, system, and program to

implement the method, system, and program of claims 1, 7, and 13 further including:

- (a) analyzing contents of the file to discover elements irresolvable by a printer; and,
- (b) resolving the elements of the file irresolvable by the printer.

Crandall et al discloses an apparatus and computer program to implement the method of analyzing contents of print files for irresolvable elements such as fonts, images, and patterns and correcting them (column 1, lines 50-52, column 1, lines 28-35, column 2, lines 2-4).

Khandelwal, Hidaka et al, and Crandall et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the analysis of irresolvable elements of Crandall et al with the print system of Khandelwal in view of Hidaka et al to implement printing with correction of irresolvable elements.

The motivation to combine the reference is clear because Crandall et al teaches that before printing a check needs to be performed to make sure all the elements can be printed (column 1, lines 28-35).

Regarding claims 5, 11, and 17, Khandelwal in view of Hidaka et al further in view of Crandall et al teach all the limitations of claims 4, 10, and 16. Further Crandall et al disclose the method of claim 4 wherein the elements irresolvable by the printer include fonts, images, and patterns irresolvable by the printer (column 1, lines 50-52; column 1, lines 28-35; column 2, lines 2-4).

5. Claims 6, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6934044 to Khandelwal in view of U.S. Patent No. 6782402 to Hidaka et al further in view of U.S. Patent No. 6268924 to Koppolu et al.

Regarding claims 6, 12, and 18, Khandelwal in view of Hidaka et al teaches all the limitations of claims 1, 7, and 13 respectively. However Khandelwal in view of Hidaka et al does not disclose method, system, and program to open user interface for providing users with printing options.

Koppolu et al disclose method, system, and program to open user interface for providing users with printing options (Figure 5, reference 203; column 15, lines 41-45).

Khandelwal, Hidaka et al, and Koppolu et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the user interface taught by Koppolu et al with the print system of Khandelwal in view of Hidaka et al to implement options for users to select before printing.

The motivation to combine the reference is clear because printer users need options to select before printing.

***Other Prior Art Cited***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6785867 to Shaffer et al disclose automatic application loading for e-mail attachments.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

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PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***Patent Examiner***

Beniyam Menberu

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02/07/2006

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